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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,805	01/12/2001	Edwin Michael Grote	P04846US0 PHI 1378	2730

27142 7590 12/27/2002

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EXAMINER

KRUSE, DAVID H

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 12/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,805

Applicant(s)

GROTE ET AL.

Examiner

David H Kruse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 5,6,20 and 33 is/are allowed.
- 6) ☐ Claim(s) 1-4, 7-19, 21-32 and 34-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This Office action is in response to the Amendment and Remarks filed 16 October 2002.
2. New claims 33-41 have been added as requested.
3. Those rejections not specifically addressed in this Office action are withdrawn in view of Applicant's amendments and Remarks.
4. The objections to claims 1, 5, 6, 7, 12 and 16 are withdrawn in view of Applicant's amendments and remarks regarding the deposit of biological materials.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

6. Claims 1-4, 7, 9-11, 13-18, 21, 22-24, 26, 27, 29, 30, 31 and 32 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is repeated for the reason of record as set forth in the last Office action mailed 16 July 2002. Applicant's arguments filed 16 October 2002 have been fully considered but they are not persuasive.

At claim 1, line 1 and claim 7, line 3, the parenthetical phrase "(commercial designation)" renders the claim indefinite because it is unclear this is a limitation within the claim, hence it is unclear what the metes and bounds of the claim are. Deletion of this phrase would obviate this rejection, as the phrase appears to be irrelevant to the claimed invention.

Claims 2-4 are indefinite because the limitations within said claims do not obviate the indefiniteness of claim 1.

Claims 9, 13, 17, 22, 26 and 30 remain indefinite because the claims do not set forth any positive method steps leading to the maize plant at line 1 of the claims. Hence, it is unclear what the metes and bounds of the claimed methods are. Applicant argues that the techniques described in the present application clearly define and distinctly claim positive method steps for producing maize plants for small or large scale production (page 12, 4th paragraph of the Remarks). The Examiner responds that this argument equates the disclosure with what is claimed in the instant claims. The Applicant is reminded that limitations within the specification are not read into the claims, although limitations within the claims must be supported by the written description within the specification.

Claims 10, 14, 18, 23, 27 and 31 are indefinite for being dependent upon an indefinite claim. The limitations within said claims do not obviate the indefiniteness of the claim upon which they depend.

Claims 11, 15, 19, 24, 28 and 32 remain indefinite because the phrases "excellent yield potential", "good stalk lodging resistance" and "suited to...of the United States", for example, are relative and do not state the metes and bounds of the claimed invention. Applicant argues that the terminology used is well known in the art and commonly used within breeding techniques for hybrid plants. Applicant also argues that the claim indicates that the traits must be originating from X1069G (page 13, 2nd paragraph of the Remarks). The Examiner responds that the instant claims are not

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limited to hybrid plants. In addition, it remains the Examiner's opinion that the claim limitations are relative. It is clear from the art that the recited traits are not specific to hybrid maize plant X1069G, hence it is unclear what the metes and bounds of the claimed invention are.

Claims 16 and 29 remain indefinite because a hybrid maize plant is not produced by a backcrossing technique. Hence, it is unclear what the metes and bounds of these claims are. Applicant argues that the specification specifically says "recurrent selection breeding, backcrossing for example, can be used to improve inbred lines in a hybrid...to transfer a specific desirable trait from one inbred or source to an inbred that lacks that trait" (page 14, 3rd paragraph of the Remarks). The Examiner responds that limitations within the specification are not read into the claims, although limitations within the claims must be supported by the written description within the specification as discussed supra. This is not a rejection for enablement. In the Examiner's opinion, the claim limitation "transferred by backcrossing" is contrary to the meaning of the claim, hence the metes and bounds of the claim are unclear. The claim does not stipulate that the "one or more genes" are transferred to a parental line prior to production of the hybrid maize plant X1069G.

Claims 8 and 21 remain indefinite because the plant of claims 2 and 20, respectively, are not male sterile. Applicant's amendments to claims 8 and 21 are noted. However the claims remains indefinite because it is confusing to denote the fertile hybrid maize plant X1069G as male sterile.

The cancellation of claims 8 and 21, and the submission of the following proposed new claims would obviate this rejection:

-- New claim 42. A method of producing a male sterile corn plant comprising transforming the corn plant of claim 2 with a nucleic acid molecule that confers male sterility.

New claim 43. A male-sterile corn plant produced by the method of claim 42.

New claim 44. A method of producing a male sterile corn plant comprising transforming the corn plant of claim 20 with a nucleic acid molecule that confers male sterility.

New claim 45. A male-sterile corn plant produced by the method of claim 44. --

7. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 11, 15, 19, 24, 28 and 32

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recites the broad recitation "a relative maturity of approximately 105", and the claim also recites "(106 for physiological maturity)" which is the narrower statement of the range/limitation. In addition the parenthetical limitation renders the claims indefinite because it is unclear if this is an actual limitation within the claim.

8. Claims 11, 15, 19, 24, 28, 32, 34, 39, 40 and 41 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At claims 11, 15, 19, 24, 29, 32, 39 and 40, the limitations "wherein said maize plant has derived at least 50% of its ancestral alleles from X1069G" and "deriving at least 50% of its ancestral alleles from X1069G" appear to be new matter, which is not permitted under 37 CFR § 1.53(b) and 35 USC § 132(a). The Examiner notes that Applicant points out at page 15, 4th paragraph, of the response filed 16 October 2002, where the amendment to claims 11, 15, 19, 24, 29, 32, 39 and 40 is supported in the instant specification. However, the Examiner does not find literal support for this limitation in the specification at the locations designated in Applicant's response. Hence, it is unclear from the instant specification that Applicant had contemplated such a claim limitation at the time of Applicant's invention.

At claims 34 and 41, the subject matter directed to producing double haploids of the described hybrid maize plant X1069G appears to be new matter, which is not permitted under 37 CFR § 1.53(b) and 35 USC § 132(a). The Examiner notes that Applicant does not specifically point out in the response filed 16 October 2002, where

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claims 34 and 41 are supported in the instant specification. Hence, it is unclear from the instant specification that Applicant had contemplated such a claim at the time of Applicant's invention.

9. Claims 11, 12, 15, 16, 19, 24, 25, 28, 29 and 32 remain rejected and claims 8-10, 13, 14, 17, 18, 21-23, 26, 27, 30, 31 and 34-41 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is repeated for the reason of record as set forth in the last Office action mailed 16 July 2002 for claims 11, 12, 15, 16, 19, 24, 25, 28, 29 and 32. Claims 9, 10, 13, 14, 17, 18, 22, 23, 26, 27, 30 and 31 are now included in the rejection because these claims are broadly drawn to a method of using a multitude of non-exemplified, uncharacterized breeding partners in an unlimited number of crosses, given the open claim language and the failure to specify that an F1 hybrid is produced. Claims 8 and 21 are now included in the rejection because the specification does not describe a plant which is simultaneously male fertile and male sterile. Claims 34 and 35-41 are new claims and will be addressed below. Applicant's arguments filed 16 October 2002 have been fully considered but they are not persuasive.

Applicant argues that they have identified the claimed plants by defining a particular threshold that limits variation and reciting a functional test to identify such plants (paragraph spanning pages 15-16 of the Remarks). Applicant argues that under the written description requirement, Applicant should be allowed to claim the progeny of

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a cross of maize plants crossed with X1069G with phenotypic characteristics since they are distinguishing identifying characteristics (page 16, 1st paragraph of the Remarks). Applicant argues that one of ordinary skill in the art is reasonably appraised in knowing that a plant crossed with X1069G will result in a plant having half of the genetic contribution of X1069G and must be capable of expressing a combination of at least two phenotypic characteristics of X1069G (page 16, end of 1st paragraph of the Remarks). This argument is not found to be persuasive because the instant claims are directed to progeny of a hybrid maize plant designated X1069G that is produced by crossing two inbred parental maize plants designated GE535769 with GE515721. Applicant does not describe any unique feature of said hybrid maize plant that would distinguish it's progeny from say the hybrid maize plant designated 36B08 (U.S. Patent 6,169,234) which shares the common parental inbred maize plant GE515721. In addition, because the hybrid maize plant designated X1069G is a cross between two inbred parental maize plants, the actual genetic complement of each individual hybrid maize plant designated X1069G could be slightly different from another hybrid maize plant designated X1069G due to recombination of genetic material. This difference would be amplified in progeny of the hybrid maize plant designated X1069G due to crossing over at random loci and segregation. Hence, it is unclear that Applicant can adequately describe a progeny plant produced from the hybrid maize plant designated X1069G as claimed.

Applicant argues that a person having skill in the art could insert a DNA gene into a selected maize plant and that Applicants have defined transgenes in the present

application (page 16, 2nd paragraph of the Remarks). This argument is not found to be fully persuasive because claims 12-15, 16-19 and 25-28 are directed to a transformed hybrid maize plant designated X1069G, and methods of using same, said transformed hybrid maize plant comprising any transgene. Given the breadth of the invention in the instant claims it is unclear if Applicant was in possession of such a broad genus of transgenic hybrid maize plants at the time of the invention because Applicant does not clearly describe what effect all transgenes would have on the hybrid maize plant designated X1069G.

Applicant's argument concerning the test for definiteness on page 17, 2nd paragraph is irrelevant to the instant rejection.

Claims 9, 10, 13, 14, 17, 18, 22, 23, 26, 27, 30 and 31 are now included in the rejection because these claims are broadly drawn to a method of using a multitude of non-exemplified, uncharacterized breeding partners in an unlimited number of crosses, given the open claim language and the failure to specify that an F1 hybrid is produced. Because Applicant has failed to adequately describe the starting materials in the methods of the instant claims, Applicant cannot adequately describe a method of using said starting materials.

Claims 8 and 21 are now included in the rejection because the specification does not describe a plant which is simultaneously male fertile and male sterile.

Claims 34 and 35-41 lack adequate written description because, at claims 34 and 41, Applicant does not describe a method of making a double haploid of the hybrid maize plant designated X1069G. At claims 36-41 Applicant does not adequately

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describe successive filial generations of the hybrid maize plant designated X1069G as claimed in claims 36, 37, 39 and 40 and thus does not describe how to practice methods using such filial generations of the hybrid maize plant designated X1069G in claims 35 and 38. Hence, it is unclear from the instant specification that Applicant was in possession of the invention as broadly claimed.

10. Claims 13, 14, 17, 18, 26, 27, 30 and 31 remain rejected and claims 8-11, 12, 15, 16, 19, 21-24, 25, 28, 29, 32 and 34-41 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is repeated for the reason of record as set forth in the last Office action mailed 16 July 2002 for claims 13, 14, 17, 18, 26, 27, 30 and 31. Claims 8-11, 12, 15, 16, 19, 21-24, 25, 28, 29, 32 34 and 35-41 are now included in the rejection because these claims are broadly drawn to non-exemplified progeny plants, methods of using a multitude of non-exemplified, uncharacterized breeding partners in an unlimited number of crosses, given the open claim language and the failure to specify that an F1 hybrid is produced. Claims 8 and 21 are now included in the rejection because the specification does not describe a plant which is simultaneously male fertile and male sterile. Claims 34 and 35-41 are new claims. Applicant's arguments filed 16 October 2002 have been fully considered but they are not persuasive.

Applicant argues that the claims have now been amended to properly be drawn from a method thereby obviating this rejection and that Applicant has clearly described

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and distinctly claimed the subject matter Applicants regard as the invention (page 17, 4th and 5th paragraph of the Remarks). This argument is not found to be persuasive for the reasons given supra for the lack of adequate written description and for the reasons given as follows.

Applicant has provided limited guidance for how to make and use the hybrid maize plant designated X1069G in the instant specification. The nature of the art at the time of Applicant's invention was such that one of skill in the art could not reasonably predict what the product of a cross between two inbred parental plants would be without a reduction to practice. The art teaches that based on the number of segregating genes, the frequency of occurrence of any individual with a specific genotype is less than 1 in 10,000 and that even if the entire genotype of the parents has been characterized and the desired phenotype is known, only a few if any individuals having the desired genotype may be found in a large F_2 or S_0 population and that typically the genotype of neither the parents nor the desired genotype is known in detail (see Segebart, U.S. Patent 5,304,719, in particular the paragraph spanning columns 2-3). The art also teaches that the number of genes affecting the trait of primary economic importance in maize, grain yield, has been estimated to be in the range of 10-1000 and that inbred lines which are used as parents for breeding crosses differ in the number and combination of these genes (Segebart, U.S. Patent 5,367,109, column 2, lines 60-64). Segebart ('109) also teaches that one of the largest plant breeding programs in the world does not have a sufficiently large breeding population to be able to rely upon "playing the numbers" to obtain successful research results and that plant breeders use

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their skills, experience and intuitive ability to select inbreds having the necessary qualities (column 4, 1st and 2nd paragraphs). Hence, given the fact that one of skill in the art cannot reasonably predict the number of genes that affect the trait of grain yield of the parental inbred lines of a hybrid maize plant, it is unclear how one of skill in the art could reasonably predict how to make and use the claimed maize plants and methods of making a maize plant using a second or filial non-exemplified maize plant produced from Applicant's exemplified hybrid maize plant. At claims 11, 15, 19, 24, 28 and 32, the listed X1069G traits, such as "excellent yield potential", "good stalk lodging resistance" or "very good ear retention", for example, are regulated by multiple, non-exemplified genes and that Applicant has failed to teach one of skill in the art how to make the claimed maize plants, even such maize plants having at least 50% of its ancestral alleles from X1069G, because one of skill in the art could not predictably identify such a plant without undue trial and error experimentation.

The following amendments would obviate the rejections under 35 USC § 112, first paragraph:

Replace claims 8 and 21 with claims 42-45 as suggested to overcome the rejection under 35 USC § 112, second paragraph.

Cancel claims 9-19, 22-32 and 34-41.

Submit new claims 46-55 below (support for said claims can be found in the specification, pages 49-54).

-- New claim 46. A method of producing an herbicide resistant corn plant comprising transforming the corn plant of claim 2 with a transgene that confers herbicide resistance.

New claim 47. An herbicide resistant corn plant produced by the method of claim 46.

New claim 48. A method of producing an insect resistant corn plant comprising transforming the corn plant of claim 2 with a transgene that confers insect resistance.

New claim 49. An insect resistant corn plant produced by the method of claim 48.

New claim 50. A method of producing a disease resistant corn plant comprising transforming the corn plant of claim 2 with a transgene that confers disease resistance.

New claim 51. A disease resistant corn plant produced by the method of claim 50.

New claim 52. A method of producing a corn plant with decreased phytate content comprising transforming the corn plant of claim 2 with a transgene encoding phytase.

New claim 53. A corn plant with decreased phytate content, produced by the method of claim 52.

New claim 54. A method of producing a corn plant with modified fatty acid or carbohydrate metabolism comprising transforming the corn plant of claim 2 with one or more transgenes encoding a protein selected from the group consisting of stearyl-ACP

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desaturase, fructosyltransferase, levansucrase, alpha-amylase, invertase, and starch branching enzyme.

New claim 55. A corn plant produced by the method of claim 54. --

Claim Rejections - 35 USC § 102/103

11. Claims 11, 15, 19, 24, 28, 31 and 32 remain rejected and claims 36, 37, 39 and 40 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Fullerton (US Patent 6,169,234 B1, filed 1 March 1999). This rejection is repeated for the reason of record as set forth in the last Office action mailed 16 July 2002. Applicant's arguments filed 16 October 2002 have been fully considered but they are not persuasive.

Applicant argues that the claimed plant cannot be rendered obvious as it possesses a unique combination of traits, which confers a unique combination of genetics (page 18, 2nd paragraph of the Remarks). The Examiner withdraws the rejection as it is directed to the hybrid maize plant designated X1069G. The Examiner maintains the instant rejection as it is directed to subsequent progeny plants.

Applicant's arguments are not found to be persuasive because the hybrid maize plant designated X1069G of the instant invention clearly shares 50% of it's inheritance with the hybrid maize plant designated 36B08 disclosed by Fullerton. Hence, progeny of the instant hybrid maize plant would have been anticipated or at least obvious in view of the teachings of Fullerton. In addition, a double haploid plant produced from the hybrid maize plant designated X1069G of the instant inventions could, in theory, reproduce the GE14721 parental inbred maize plant previously disclosed by Fullerton.

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Applicant argues that the claims do not simply recite traits, but instead recites those specific traits only to the extent that they are "X1069G" traits, thereby being derived from the seed/germplasm of X1069G. Applicant also argues that the claim also recites that the claimed plant must have X1069G as an ancestor further indicating that these traits must originate from the X1069G plant and not 36B08 (page 19, 4th paragraph of the Remarks). This argument is not found to be persuasive because clearly the hybrid maize plant 36B08 taught by Fullerton has inherited half of its genome from an identical parental inbred line and thus the maize plant taught by Fullerton would be capable of transferring genes directed to the same traits inherited in of the instant invention. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products. Clearly the product of the instant claims can be produced using the product taught by Fullerton. The relative traits Applicant recites in claims 11, 15, 19, 24, 28 and 32 are the result of the combinations of the two parental inbred lines, one of which is shared by the maize plant of Fullerton. In addition, given that one of ordinary skill in the art does not have control over how the genes recombine in a hybrid cross, the maize plants of the instant claims are anticipated or in the alternative obvious over the teachings of Fullerton.

Applicant argues that there is no expectation of success that the crossing of the hybrid 36B08 with some yet to be identified plant would yield a plant with two traits enumerated in the claimed invention and at least 50% of its ancestral alleles from

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X1069G because that particular plant did not begin with the claimed seed X1069G which is essential (page 20, 1st paragraph of the Remarks). This argument is not found to be persuasive. The issue of indefiniteness is related to the relative limitations at claims 11, 15, 19, 24, 28 and 32. The Examiner reiterates that because the 36B08 hybrid maize plant of Fullerton and the X1069G hybrid maize plant of the instant invention share a common parental inbred, one of ordinary skill in the art would expect that one could produce identical progeny plants using either 36B08 or Applicant's X1069G because of the shared inheritance.

Applicant argues that Hybrid 36B08 does not exhibit the same characteristic as X1069G which has superior resistance to Fusarium Stalk Rot, different Fresh Husk Color, different Staygreen, different length of ear node leaf and different comparative relative maturity (pages 21 and 22 of the Remarks). The Examiner accepts these arguments to the extent they are directed to the non-anticipation or obviousness of X1069G in view of the teachings of Fullerton of the hybrid 36B08, but these arguments are not persuasive as directed to progeny plants of X1069G because each of the above listed traits are controlled not only by the maize plant taught by both Fullerton and/or Applicant, but also by the second parental maize plant one of ordinary skill in the art would choose as a crossing partner.

Double Patenting

12. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 11, 15, 19, 24, 28, 31 and 32, 34, 36, 37, 39, 40 and 41 tr rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 10-12, 20, 26 and 29 of U.S. Patent No. 6,169,234.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Fullerton discloses a hybrid maize plant designated 36B08 (see claim 2), which Applicant admits is similar to the hybrid maize plant of the instant invention (see page 21, paragraph 1 of the instant application). The X1069G maize hybrid of the instant invention shares a common parent with the 36B08 maize hybrid of Fullerton, that being the proprietary inbred maize line GE515721 (see column 5, last paragraph). Said 36B08 hybrid maize plant inherently discloses such relative traits as "good test weight", "moderate resistance to Grey Leaf Spot" and "good root lodging resistance" (see for example claim 10). While the hybrid maize plant of Fullerton is designated 36B08 and the hybrid maize plant of the instant claims is designated X1069G, there are insufficient identifying characteristics set forth in the claims to distinguish progeny of the claimed plants wherein the exemplified X1069G hybrid maize plant is an ancestor from progeny of the 36B08 hybrid maize plant of the prior art.

Conclusion

14. This Office action is non-final.
15. Claims 5, 6, 20 and 33 are allowed.
16. Claims 1-4, 7-19, 21-32 and 34-41 are rejected.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (703) 306-3218. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

David H. Kruse, Ph.D.
20 December 2002

DAVID H. KRUSE
1638
David H. Kruse